

REMARKS

Claims 11-19 and 21-29 are pending in this application. Claims 11-19 and 21-29 are amended. Claims 1-10 and 20 have been canceled without prejudice to or disclaimer of the underlying subject matter.

No new matter is introduced. Reconsideration and prompt allowance of the claims are respectfully requested.

Claims 11-17, 19, 21-27 and 29 have been amended to remove unnecessary language and to correct dependencies. No surrender of claims scope was intended by these amendments.

The Office Action rejects claims 10-29 under 35 U.S.C. § 103(a) as being unpatentable over Hartrick et al., U.S. Patent No. 5,532,920 (hereafter *Hartrick*) in view of Ross, U.S. Patent No. 5,465,532 (hereafter *Ross*).

Applicant respectfully submits that the Office Action does not establish a prima facie case of obviousness as required by the MPEP. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, finally the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02 (j).

The Office Action does not establish a prima facie case of obviousness since neither *Hartrick* nor *Ross*, applied separately or in combination, disclose or suggest all of the features of the claimed invention.

Neither *Hartrick* nor *Ross*, applied separately or in combination, disclose or suggest a method for storing text for electronic books to be displayed on a viewer which includes

selectively displaying pages for the selected electronic book; and
downloading text material for the selected electronic book from a portable
storage medium, wherein the downloading includes limiting access to the
text material based upon a time parameter,

as recited, among other features, in independent claims 18 and 28 (both as presented). It is noted that independent claim 18 (as presented) includes features of claim 10 (now canceled), and independent claim 28 (as presented) includes features of claim 20 (now canceled).

Hartrick is directed to a data processing system and method to enforce payment of royalties when copying softcopy books. As disclosed in *Hartrick*, to read a book from a

storage disk, a user applies a special softcopy book reading program at his workstation. If the user enters a command to copy the book onto a writable storage medium such as a magnetic disk or to print a hardcopy of the book with a printer or to transmit a copy of the book over a modem, a royalty payment program intercepts the copying command and suspends the copying operations. Instead, the royalty payment program presents the user with a display of the royalty payment information stored in the book text or in a file accompanying the book. The user must select the option of paying a royalty to the publisher before the royalty payment program permits a copy of the book to be made. *See, e.g.*, Abstract and col. 4, line 58 to col. 5, line 3. Thus, *Hartrick* teaches that user must select the option of paying a royalty to the publisher before the royalty payment program permits a copy of the book to be made.

However, *Hartrick* does not disclose or suggest “limiting access to the text material based upon a time parameter,” as recited, among other features, in claims 18 and 28.

The Office Action does not provide any citation in the rejections of claims 18 and 28. The Office Action merely states that “[o]fficial Notice is taken that ‘limiting access to the text material based upon a time parameter’ is common and well known in prior art in reference to digital media. It would have been obvious to one having ordinary skill in the art at the time the invention was made to limit access to the text material based upon a time parameter in order to maximize the potential profitability of the media [b]y allowing it to be repurchased in the future.”

Applicant traverses these rejections. Neither *Hartrick* nor *Ross* does not disclose or suggest, at least, “limiting access to the text material based upon a time parameter,” as claimed. Moreover, the Office Action does not provide any secondary reference disclosing “limiting access to the text material based upon a time parameter,” as claimed. The Office Action takes Official Notice that the claimed features were known at the time of invention. However, the MPEP § 2144.03 indicates that it would **not** be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known (emphasis in original). Applicant requests that the Office Action provides a reference citation that discloses the claimed features or withdraw the rejection.

Moreover, even if such a reference was provided, the Office Action does not provide any motivation, as required by the MPEP, to modify the royalty enforcement system of *Hartrick* to include “limiting access to the text material based upon a time parameter,” as claimed.

Since the Office Action fails to provide a reference disclosing “limiting access to the text material based upon a time parameter” and fails to provide any motivation to combine “limiting access to the text material based upon a time parameter” with *Hartrick*, the Office Action fails to establish a *prima facie* case of obviousness with respect to the claimed invention.

Since the Office Action fails to establish a *prima facie* case of obviousness with respect to independent claims 18 and 28, Applicant submits that independent claims 18 and 28 are in condition for allowance over the applied art for at least these reasons.

Applicant submits that *Ross* fails to overcome the deficiencies of *Hartrick* as described above. For example, *Ross* does not disclose or suggest “limiting access to the text material based upon a time parameter,” as claimed. Therefore, claims 18 and 28 are in condition for allowance over the applied art for at least the reasons described above.

With respect to dependent claims 19 and 29, the Office Action takes “Official Notice” that “limiting access to the text material based upon a number of downloads and viewing of the text material,” as claimed, is common and well known in prior art in reference to digital media. Applicant traverses these rejections. Applicant requests that the Examiner provides a reference citation that discloses the claimed features and provide a motivation to combine the disclosed features with the applied art. As stated above, MPEP § 2144.03 indicates that it would **not** be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known (emphasis in original).

For example, the applied art does not disclose or suggest a “limiting access to the text material based upon a number of downloads and viewing of the text material,” as recited in dependent claims 19 and 29. Applicant requests that a reference disclosing a “limiting access to the text material based upon a number of downloads and viewing of the text material,” and providing a motivation to combine the limiting access, as claimed, be cited or the rejection with respect to dependent claims 19 and 29 be withdrawn.

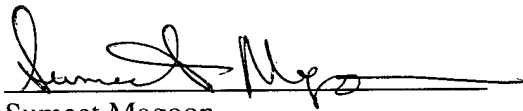
Claims 11-17 and 19 depend from independent claim 18, and claims 21-27 and 29 depend from independent claim 28. Therefore, claims 11-17, 19, 21-27 and 29 are allowable for

the reasons stated above with respect to the claims from which they depend, and for the additional features recited therein.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sumeet Magoon', written over a horizontal line.

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